

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested. By this Amendment, Applicant has added new claims 6-9. Thus, claims 1-9 are now pending in the application. In response to the Office Action (Paper No. 18), Applicant respectfully submits that the pending claims define patentable subject matter.

**I. Preliminary Matters**

Claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claim 1 is also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because the Examiner maintains that the limitation “the switching frequency” at line 11 lacks a proper antecedent basis.

With regard to the enablement rejection, the Examiner, citing *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976), asserts that “the term “switching frequency” is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure” (emphasis added). The Examiner further asserts that “there is no mentioning of the term “switching frequency”, and even if it [is] mentioned in the specification, the term does not provide any novelty.”

However, the Examiner’s position regarding the alleged lack of enablement is unclear since the claims do recite the term “switching frequency”. Similarly, the Examiner’s reliance on *In re Mayhew* is not understood as the case stands for the proposition that when the specification teaches that a feature of the invention is critical and the critical feature is not recited in the

claims, the claims are not enabled because the specification does not support the invention recited in the claims absent the critical feature (i.e., the Examiner appears to be implicitly admitting this feature of the claimed invention is disclosed and supported by the specification). Further, Applicant respectfully submits that the Examiner's disparaging comments regarding the novelty of this feature of the claimed invention are improper and have no relevance to the issue of enablement under 35 U.S.C. § 112, first paragraph.

Nonetheless, Applicant has amended claim 1 to improve clarity by reciting "an output data switching portion for performing switching control to increase a frequency with which data is output from the prediction memory and the B picture memory ...." Applicant respectfully submits that the subject matter of the amendment to claim 1 is fully supported and enabled by the specification which teaches the frequency of the read clock signal of the prediction memories and the B picture memory is set to be double that of the general scanning method (see, for example, page 6, line 27 - page 7, line 26).

Accordingly, the Examiner is requested to remove the § 112 rejections.

## **II. Prior Art Rejections**

Claims 1 and 3-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by newly cited Heimburger (U.S. Patent 5,889,890). Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Heimburger in view of newly cited Hackett (U.S. Patent 5,642,170).

Applicant respectfully submits the claimed invention would not have been anticipated by or rendered obvious in view of Heimburger.

Although the Examiner alleges that “element 1 can store I pictures” and “element 3 can store P and B pictures” (see Fig. 2 of Heimburger), the alleged possibility these elements could store the claimed I, P and B pictures does not satisfy the requirements for anticipation under 35 U.S.C. § 102. That is, anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. See *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983). Further, while anticipation can be shown by inherency, it is well settled that inherency cannot be established by probabilities or possibilities, and the fact that a certain thing may result from a given set of circumstances is insufficient to establish inherency. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

Heimburger, which was filed well after the MPEG standard was established, does not discuss or even mention the MPEG standard or restoring I, P and B pictures of MPEG signals. Further, the Examiner’s assertion that Heimburger’s type 1 fields are I pictures, Heimburger’s type 2 fields are P pictures and Heimburger’s type 3 fields are B pictures is not supported by the teachings of the cited Heimburger. That is, the cited reference simply teaches that output fields 1, 4, 7 ... are type 1 fields, output fields 2, 5, 8 ... are type 2 fields and output fields 3, 6, 9 ... are type 3 fields. Thus, since the Examiner has not established that the applied reference includes each and every feature of the claimed invention, the reference is not properly a § 102 reference at all.

Moreover, Applicant respectfully submits that it is quite clear that Heimburger does not teach or suggest the claimed prediction memory switching portion and/or the claimed output data switching portion. With regard to the claimed memory switching portion, the Examiner cites column 4, line 6 to column 5, line 9 of Heimburger for allegedly disclosing “the data output from

the decoding block to the prediction memory [element 1] or the B picture memory is switched, where there are P pictures also know as type 2, or B pictures, also know as type 3.” However, Heimburger does not teach or suggest switching multiple types of data (i.e., the I picture data, the P picture data and the B picture data) output from a decoding block to multiple memories (i.e., the prediction memory or the B picture memory) depending on the type of picture. Rather, data output from the noise reduction circuit 2 goes to a single memory device, i.e., field memory 3.

With regard to the claimed output data switching portion, the Examiner cites column 5, line 60 to column 7, line 5 and asserts that “the motion estimator [5] applies all of the information needed to process the increasing of the switching frequency of data stored in memory 3 and the outputting of the converted data.” However, the motion estimator does not perform switching control to increase a frequency with which data is output from the prediction memory and the B picture memory with respect to a general scanning method, as claimed. That is, the motion estimator 5 has no control over the field memory 3 or the frequency at which data is output from the field memory 3.

Lastly, Applicant respectfully submits that it is quite clear that Hackett does not teach or suggest these features of the claimed invention which are missing from Heimburger.

Accordingly, Applicant respectfully submits that claims 1-5 should be allowable over Hackett, alone or in combination with Heimburger, since the cited references do not teach or suggest all of the features of the claims.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Patent Application No. 09/328,007

### III. New Claims

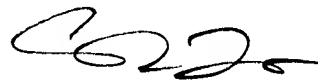
By this Amendment, Applicant has added new claims 6-9. Applicant respectfully submits that claims 6-9 should be allowable for the same reasons set forth above with regard to claims 1-5.

### IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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CUSTOMER NUMBER

Date: May 17, 2004

Attorney Docket No.: Q54451